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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,964	09/24/2003	Yukihiko Minamida	031206	1481

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,964

Applicant(s)

MINAMIDA ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 27, 2006 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmeke et al. ('073) in view of Lee et al. ('793) or Oertel.

Helmeke et al. disclose moisture curable hot melt polyurethane adhesives, wherein the adhesives comprise polyurethane prepolymers, derived from diphenylmethane diisocyanate and polyester polyols. Patentees further disclose that the polyester is derived from polyols and phthalic acid. Furthermore, morpholine ether catalysts are disclosed as being preferred. See

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abstract; column 1, lines 50-59; column 2, lines 50+; column 3, lines 1-4 and 65+; column 4, lines 44-53; and examples.

4. Helmeke et al. are silent regarding the incorporation of sulfonic acids into the adhesive compositions; however, sulfonic acids were known inhibitors for isocyanate reactions, especially in the presence of amine catalysts, such as applicants' claimed morpholine ether catalyst. This position is supported by the teachings of Oertel at pages 96 and 97 and Lee et al. (see abstract).

It is noted that Lee et al. disclose at column 6, lines 50-53 that alternative prepolymer embodiments may be employed, such as those disclosed within U.S. Patent 4,411,262 (U.S. Patent 4,411,262 discloses polyurethane prepolymers derived from polyester polyols).

Therefore, the position is taken that it would have been obvious to incorporate sulfonic acids into the amine catalyzed polyurethane prepolymer adhesives of the primary reference, so as to extend shelf life, potlife, and workability of the adhesive.

5. The examiner has considered the 37 CFR 1.132 declaration of April 13, 2005; however, the declaration is insufficient to overcome the prior art rejection for the following reasons.

Firstly, the declaration is not commensurate in scope with the claims, with respect to species and quantities of components. Secondly, applicants' results are not unexpected. The most relevant comparison stems from a review of Comparative Example 3 and Example 1, wherein the difference appears to be that Example 1 employs a sulfonate compound (it is noted that the methane sulfonate does not correspond to the claimed acid compounds, so the declaration is additionally deficient for this reason). The results of this comparison are what one of ordinary skill in the art would expect, considering the disclosed function of the inhibitor compounds.

Specifically, Example 1 displays a slower viscosity build and decreased creep resistance,

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suggesting a longer open-time. Since sulfonic acid inhibitors retard the reaction, these are exactly the results that one would expect from its addition to the adhesive composition.


6. The examiner has considered the 37 CFR 1.132 declaration of February 27, 2006; however, the declaration is insufficient to overcome the prior art rejection for the following reasons. Firstly, this second declaration is also not commensurate in scope with the claims, with respect to species and quantities of components. It has been held that to overcome a reasonable case of *prima facie* obviousness, the claims must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Furthermore, it has been held that a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. The position is taken that applicants' declarations fail to meet these standards. Furthermore, it has been held that where a comparative standard may be used, the comparison must relate to the prior art embodiment relied upon and not other prior art. *Blanchard v. Ooms*, 68 USPQ 314. In other words, applicants' comparative examples must be representative of the closest available prior art, specifically, Helmeke et al. With respect to the declaration of February 27, 2006, Comparative Examples (2) and (3) lack components possessed by Helmeke et al. Specifically, Comparative Example (2) lacks the catalyst and Comparative Example (3) lacks the phthalic acid based polyester polyol. Therefore, these Comparative Examples are not representative of Helmeke et al. and are not considered to be relevant to the issues at hand. Accordingly, the only relevant comparison is that of Comparison (1), and the position is taken that this comparison fails to demonstrate an unexpected result. As with the previously argued comparison of the previous declaration, Comparison (1) is considered to demonstrate exactly what would have been expected by one of ordinary skill in the art. Example (1), containing the

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methanesulfonic acid reaction inhibitor, displays a slower reaction profile, in terms of slower viscosity build. Again, since sulfonic acid inhibitors retard the reaction, these are exactly the results that one would expect from its addition to the adhesive composition.

Any inquiry concerning this communication should be directed to R. Sergeant at telephone number (571) 272-1079.

R. Sergeant
March 16, 2006


RABON SERGENT
PRIMARY EXAMINER